



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/591,246	01/18/96	THOMSON	960296, 93723

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18M1/1218

EXAMINER	
BRUMBACK, B	
#9	
ART UNIT	PAPER NUMBER
1815	

DATE MAILED: 12/18/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/691,246

Applicant(s)
Thomson

Examiner
Brenda Brumback

Group Art Unit
1815



☒ Responsive to communication(s) filed on 09/30/97 & 10/17/97

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-11 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-11 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The examiner acknowledges receipt of the amendment and §1.131 Declaration of James Thomson on 09/30/97 and the Information Disclosure Statement on 10/17/97.

Information Disclosure Statement

2. The information disclosure statement filed 10/17/97 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but certain of the information referred to therein has not been considered, as is indicated on the attached copy of the statement.

Response to Arguments

3. The rejection of claim 1 under 35 U.S.C. 112, second paragraph, for the syntax is withdrawn subsequent to Applicant's amendment of 09/30/97 correcting it.

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4. The rejection of claims 1 and 3 under 35 U.S.C. 112, second paragraph, for the definition of "normal karotype" is withdrawn subsequent to Applicant's amendment of 09/30/97 defining the phrase.

5. The rejection of claim 1 under 35 U.S.C. 112, second paragraph, for the phrase "differentiate to derivatives" is withdrawn subsequent to Applicant's amendment of 09/30/97 clarifying it.

6. The rejection of claim 9 under 35 U.S.C. 112, second paragraph, for the typographical error, "blastocyte" is withdrawn subsequent to Applicant's amendment of 09/30/97 changing the term to "blastocyst".

7. The rejection of claims 1-11 under 35 U.S.C. 112, first paragraph, for the deposit requirement is maintained. Applicant's arguments regarding the deposit have been carefully considered but they are not persuasive. Applicant states on page 4 (last paragraph) of the response received 09/30/97 that the instant specification is sufficiently detailed in its enablement that one of ordinary skill in the art would be able to reproduce a primate embryonic cell line and that the applicant has created four such lines. The examiner does not disagree with this statement; however, as pointed out in the last Office action (mailed 03/27/97), reproduction of a cell line with identical characteristics to those of the cell line of the instant invention is an unpredictable

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event. In fact, of the lines developed by the applicant and taught in the specification, only a single line (R 278.5) appears to have all of the identifying characteristics of the instant invention. Therefore, the requirement of a deposit of this cell line for patent purposes is maintained.

Double Patenting

8. The provisional rejection of claims 1-11 as claiming the same invention as that of claims 1-11 of copending Application 08/376,327 is withdrawn due to the abandonment of 08/376, 327 effective 12/08/97.

Claim Rejections - 35 USC § 102/103

9. The rejection of claims 1-8 and 11 under 35 U.S.C. 102(a) as anticipated by, or in the alternative, under 35 U.S.C, 103(a), as obvious over Nation/World is withdrawn due to the submission of the declaration of under 37 C.F.R. 1.131 establishing practice of the invention prior to November 1, 1994.

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Claim Rejections - 35 USC § 103

10. The rejection of claims 1, 7, and 8 as unpatentable over Bongso et al. in view of Dyer et al. and Hogan; the rejection of claims 2-6 as unpatentable over Bongso et al., in view of Dyer et al. and Hogan and further in view of Damajanov; and claims 9-11 as unpatentable over Bongso et al. in view of Brown, all under 35 U.S.C. 103(a), are withdrawn subsequent to Applicant's arguments, which were persuasive, and the Declaration of James Thomson establishing practice of the invention prior to 12/08/94.

Allowable Subject Matter

11. Amendment of the instant claims to recite the limitation of the specific cell line designated as R 278.5 and compliance with the deposit requirement of this cell line for patent purposes would place the instant claims in condition for allowance.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Brumback whose telephone number is (703) 306-3220. If the examiner can not be reached, inquiries can be directed to Primary Examiner Michael Woodward whose telephone number is (703) 308-3890 or Supervisory Patent Examiner Marian Knode whose telephone number is (703) 308-4311. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Examiner Brenda Brumback, Art Unit 1815 and should be marked "OFFICIAL" for entry into prosecution history or "DRAFT" for consideration by the examiner without entry. The Art Unit 1815 FAX telephone number is (703)-305-3014. FAX

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machines will be available to receive transmissions 24 hours a day. In compliance with 1096 OG 30, the filing date accorded to each OFFICIAL fax transmission will be determined by the FAX machine's stamped date found on the last page of the transmission, unless that date is a Saturday, Sunday or Federal Holiday with the District of Columbia, in which case the OFFICIAL date of receipt will be the next business day.

Brenda Brumback

December 17, 1997


MICHAEL P. WOODWARD
PRIMARY EXAMINER
GROUP 1800